

DETAILED ACTION

1. This Office Action incorporates an Examiner's Amendment and Reasons For Allowance.
2. The Applicant's Amendment After Non-Final filed 12/20/2010 has been entered and made of record.
3. The Applicant's Supplemental Application Data Sheet ADS filed 12/20/2010 has not been entered because Supplemental Application Data Sheets identifying only the information that is being changed (added, deleted, or modified) in the supplemental ADS are not acceptable; this Supplemental Application Data Sheet does not identify the continuity information with regards to 10/090,775 and 09/920,396 {so it is unclear if they have been removed from the priority information}. MPEP 601.05
However, the Applicant's Supplemental Application Data Sheet filed 3/07/2011 has been entered and made of record.
4. The Applicant has canceled claim(s) 2.
5. The application has pending claim(s) 1, 3-8, and 10-13.
6. Applicant's arguments, see "In section 9 of the Office Action ..." in page 7 through "For at least these reasons ..." in page 8, filed 12/20/2010, with respect to

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claims 1, 3-8, and 10-13 have been fully considered and are persuasive. The 35 U.S.C. 103(a) rejections of claims 1, 3-8, and 10-13 have been withdrawn.

Priority

7. The current claims of the application are not entitled to the benefit of the prior-filed application(s) corresponding to CIP 09/314,648 05/19/1999 and provisional 60/134,782 5/19/1999 because the Examiner has not found support for the claim limitation "steganographically encoding ... plural-bit auxiliary data onto a substrate at a specific location out of a plurality of distinct locations on the substrate, wherein the plural-bit auxiliary data is based at least in part on the specific location" as recited in claim 1 {similarly in claims 12 and 13}. However the application is entitled to the benefit of the prior-filed application(s) corresponding to CON 09/343,104 6/29/1999. **Therefore the current application is entitled to the priority benefit of 6/29/1999.** If the Applicant does choose to argue this decision, it is essential that the Applicant clearly point out where the support is found and how the interpretation is being conceived.

EXAMINER'S AMENDMENT

8. An examiner's amendment to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312. To ensure consideration of such an amendment, it **MUST** be submitted no later than the payment of the issue fee.

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Authorization for this examiner's amendment was given in a telephone interview with Mr. Christopher Kalafut (Reg. No. 57,946) on May 5, 2011.

The application has been amended as follows:

For the section entitled "Related Application Data" on page 1 of the specification dated 1/23/2004, it is to be amended as follows:

1. Please replace -- 1999 (attached as Appendix A). -- in line 8 with "1999, which is hereby incorporated by reference in its entirety."

For the section entitled "APPENDIX A" on pages 59-100 of the specification dated 1/23/2004, it is to be amended as follows:

1. Please delete and cancel this entire section (pages 59-100) of the specification.

For the Drawings dated 1/23/2004, it is to be amended as follows:

1. Please delete and cancel the entire drawing sheet on sheet 3 of 4 which is labeled as -- FIG. 1 (Appendix A) --.

2. Also, please delete and cancel the entire drawing sheet on sheet 4 of 4 which is labeled as -- FIG. 2 (Appendix A) --.

REASONS FOR ALLOWANCE

9. The following is an examiner's statement of reasons for allowance:

Claims 1, 3-8, and 10-13 (now renumbered as 1-11, for issue) are allowed.

Independent claim 1 (now renumbered as claim 1, for issue) respectively recites the limitations of: steganographically encoding, using at least a processor of a computer system, plural-bit auxiliary data onto a substrate at a specific location out of a plurality of distinct locations on the substrate, wherein the plural-bit auxiliary data is based at least in part on the specific location, wherein the plural-bit auxiliary data is substantially imperceptible to casual human inspection, but is detectable through normal ambient visible light imaging of the substrate without use of non-visible light lenses or filters, wherein the plural-bit auxiliary data is encoded such that decoding of the plural-bit auxiliary data relies on a Fourier transform that produces data in which scale and rotation can be ignored, and wherein the plural-bit auxiliary data comprises or links to information regarding use of an electronic version of a document that is placed onto the substrate; and storing, in a memory of the computer system, at least a portion of the plural-bit auxiliary data in association with data identifying a location at which the electronic version of the document is stored. Similar limitations are recited in independent claims 12 (now renumbered as claim 10, for issue) and 13 (now renumbered as claim 11, for issue).

The combination of these features as cited in the claims in combination with the other limitations of the claims are neither disclosed nor suggested by the prior art of record.

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The closest reference Stephany (US 5,331,140, as applied in previous Office Action) discloses placing invisible bar codes on packages or magazines. However, Stephany does not teach the limitations cited above.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Conclusion

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bernard Krasnic whose telephone number is (571) 270-1357. The examiner can normally be reached on Mon-Thur 8:00am-4:00pm and every other Friday 8:00am-3:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bhavesh Mehta can be reached on (571) 272-7453. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should

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you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Bhavesh M Mehta/
Supervisory Patent Examiner, Art Unit 2624
/Bernard Krasnic/
Examiner, Art Unit 2624
May 6, 2011